

Paper No. 20

RLS/RLR

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SEPT 9, 97

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Hayes Microcomputer Products, Inc.

v.

Archtek America Corporation

Opposition No. 92,916
to application Serial No. 74/325,215
filed on 10/26/92

Thomas A. Hodge of Jones & Askew for Hayes Microcomputer,
Products, Inc.

Robert A. Schruhl for Archtek America Corporation

Before Sams, Simms and Hohein, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Hayes Microcomputer Products, Inc. (opposer), a Georgia corporation, has opposed the application of Archtek America Corporation (applicant), a California corporation, to register the mark "SMARTLINK" for computer peripherals, namely, modems for computers, and computer modem operating software and manuals sold as a unit for use in the field of

telecommunications.¹ In the notice of opposition, opposer asserts that it makes and sells data communications products such as computer programs, modems and other computer products; that opposer owns a number of registrations, which include the mark SMARTCOM, for computer programs for use in computer communications and similarly described products; and that applicant's mark SMARTLINK so resembles opposer's previously used and registered marks as to be likely to cause confusion, to cause mistake or to deceive. In the alternative, opposer asserts that applicant's mark is merely descriptive or deceptively misdescriptive and that applicant is not the owner of the mark herein sought to be registered. Applicant in its answer denied the essential allegations of opposer's pleading but admitted that the respective goods travel in similar channels of trade and are used for data communications. Applicant also asserted the affirmative defenses of unclean hands, laches and estoppel.

On February 29, 1996, the Board granted applicant's cross-motion for summary judgment with respect to opposer's Section 2(d) (likelihood of confusion) claim, finding that there is no genuine issue on the question of likelihood of confusion and that applicant is entitled to judgment on this claim as a matter of law. More particularly, the Board found that confusion is unlikely as a matter of law because the marks SMARTLINK and SMARTCOM are too dissimilar, especially

¹Application Ser. No. 74/325,215, filed October 26, 1992, based upon first use and first use in commerce since June 10, 1989.

in view of the fact that the term "smart" per se is widely used, non-distinctive and a merely descriptive term in the computer field. The Board reset trial dates and this case proceeded to trial on the remaining issues--whether applicant's mark is merely descriptive (or deceptively misdescriptive) and whether applicant is the owner of the mark sought to be registered.

At trial, opposer submitted a notice of reliance on portions of various printed publications, on applicant's answers to opposer's interrogatories and on applicant's responses (written responses rather than documents) to opposer's first request for production of documents. Opposer also relied upon a discovery deposition of Steven Lu. During its testimony period, applicant submitted a notice of reliance upon three third-party registrations obtained from a CD-ROM program provided by the Patent and Trademark Office for searching registered and pending trademarks. Applicant also has attempted to rely upon a declaration of its president. We have not considered this declaration. By agreement of the parties, the testimony of a witness may be submitted in the form of an affidavit. See Trademark Rule 2.123(b) and TBMP Section 716. However, no such stipulation was submitted in this case. Accordingly, the evidence must be excluded.²

²By this declaration, applicant attempts to establish that it purchases modems from Archtek Telecom Corporation, a Taiwanese corporation which applicant's president founded; that applicant performs quality control inspections on modems from this company; that applicant exclusively controls the nature and

As noted above, opposer has relied upon a number of excerpts from trade publications and matter carried on the Business Wire.³ It appears that opposer submitted these articles because of the appearance therein of the expression "smart link" and variations thereof. Many of the references contain the term "Smart Link" (or "SmartLink") as a trademark of others. For example, the following sentence appears in an article from Network Week, of March 10, 1995:

That said, the group has an aggressive development schedule, and says that it plans to release a draft version of SmartLink later this spring.

In InfoWorld, dated February 12, 1996, the following sentences appear:

Each SmartObject knows how to interact with its peers and uses SmartLinks to connect with them...

As each SmartObject was placed in the SmartWindow, Advisor dialogs helped me select and create the appropriate SmartLink between them.

Other examples appear below:

A hypertext smart link feature is perhaps the most useful component. Most HTML document links are static and must be rewritten each time a document is moved, renamed or updated. WebServer tracks these changes and automatically updates the links.

quality of the goods using the mark within this country; and that new products developed by the Taiwanese company for sale in this country are sent to applicant for performance, compatibility and quality testing. These are facts that are established, in any event, in the discovery deposition relied on by opposer.

³With respect to articles which may have been carried on the Business Wire, we have given relatively little weight to that matter because, without evidence that such articles appeared in printed publications, the exposure to the public is questionable. See *In re Manco Inc.*, 24 USPQ2d 1938, 1939 n.4 (TTAB 1992) and cases cited there.

Government Computer News, June 5, 1995;

* * * * *

Version 3.0 enhancements feature UnInstaller's SmartLink technology to let users move, archive, and transport documents and files as discrete objects.

InfoWorld, June 12, 1995;

* * * * *

Although work on the technical specifications, provisionally dubbed the SmartLink Architecture, began "several months ago," Robert Pascoe of IBM's Software Solutions Division, who chairs the consortium's operations subcommittee, said that the group's work is still at a very early stage.

Computergram International, March 23, 1995;

* * * * *

NetWare Management System 2.1 will add SmartLink, which integrates NMS "snap-in" applications, according to sources close to Novell. The current version requires administrators to access each application separately through the NMS console.

PC Week, January 16, 1995; and

* * * * *

It also reflected a 1.3 percent increase in access lines in service and an increase in revenues from premium services like Totalphone and SmartLink.

Edge, November 1, 1993.

From applicant's discovery responses, we glean the following information. Applicant's first use of its mark was in connection with sales brochures sent to computer dealers in 1989, and the first sale by applicant was made in 1990.⁴ Applicant promotes its SMARTLINK products by way of

⁴We note that the application asserts a first use of the mark as a trademark in commerce on June 10, 1989.

advertisements in computer magazines, by direct mail, at trade shows and through press releases. Archtek Telecom Corporation, a Taiwanese corporation, distributes SMARTLINK products throughout Europe. The interrogatory responses also indicate that applicant is not aware of any instances of actual confusion. The discovery deposition of applicant further establishes that Archtek Telecom Corporation, which owns 80 percent of applicant, first sold goods bearing the mark in 1986 or 1987.

Opposer has not filed a brief. Applicant, in its brief, argues that its mark does not immediately tell consumers what the goods are but rather requires the exercise of imagination, thought and perception by the consumer. Further, applicant contends that the mark sought to be registered is not in common usage by others as a description of the same or related goods or services.

We agree. On this record, it is clear that there is no evidence from which one may conclude that the mark SMARTLINK is merely descriptive of computer modems or computer modem operating software in the field of telecommunications. The excerpts relied on by opposer demonstrate use of the term "SmartLink" as a trademark (apparently owned by one or more other companies) or use of "smart link" in different contexts (e.g., "A hypertext smart link feature..."). Compare *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377 (TTAB 1994) (SMARTPROBE held merely descriptive of disposable cryosurgical probes because consumers will perceive

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applicant's mark as describing probes equipped with microprocessors).

On the question of ownership, opposer has pointed to no facts (and we are aware of none) from which we may conclude that applicant is not in fact the owner of the mark sought to be registered in this country.

Decision: The opposition is dismissed.

J. D. Sams

R. L. Simms

G. D. Hohein
Administrative Trademark Judges
Trademark Trial and Appeal Board